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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/773,608

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Michael G. Fisher

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12/01/2006

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EXAMINER

HOFFMAN, MARY C

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,608	<b>Applicant(s)</b> FISHER ET AL.	
	<b>Examiner</b> Mary Hoffman	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-117 is/are pending in the application.
- 4a) Of the above claim(s) 81-114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-80 and 115-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/6/04, 4/12/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-25-6</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

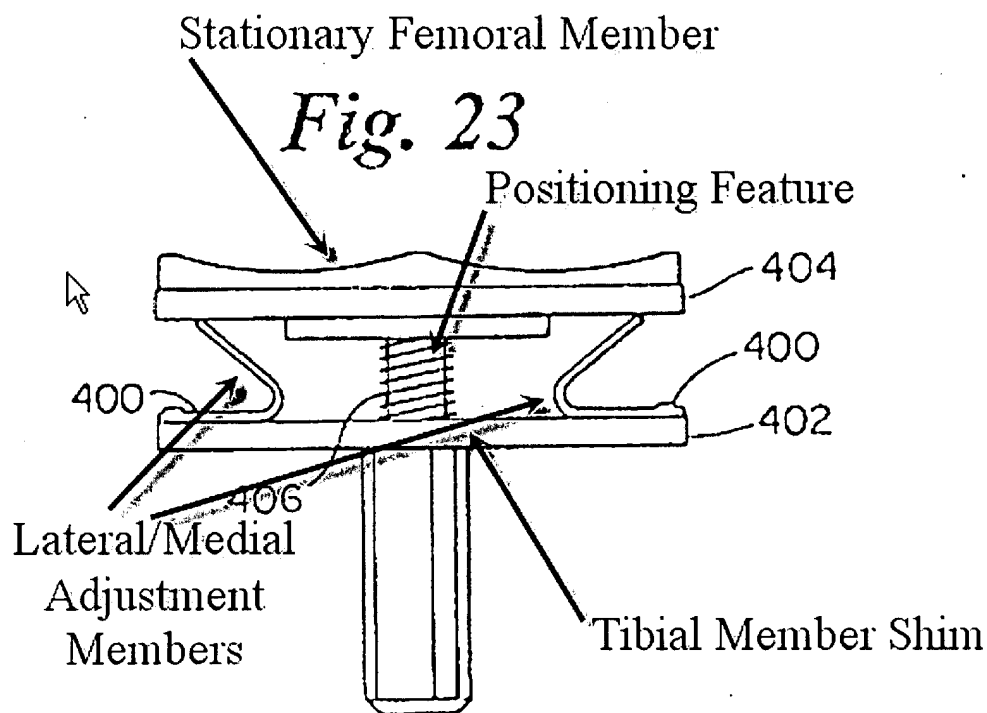
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19, 21-22, 26-28, 30-40, 42-54, 55-59, 61-62, 70-73, 74-80, 115-117 are rejected under 35 U.S.C. 102(b) as being anticipated by Gustilo et al. (U.S. Patent No. 5,733,292).

Gustilo et al. disclose a device comprising a stationary femoral member, an adjustable femoral member movably coupled with the stationary member that allows the knee to move through a range of motion (see Figure, next page). The adjustable member comprises a positioning feature. The adjustable member comprises a lateral adjustment member, and a medial adjustment member. The adjustment members are springs. The adjustment member comprises a distal femoral portion and a posterior condylar portion, the posterior condylar portion comprises a lateral and medial portion. The distal femoral portion and condylar portions comprise one piece. The stationary member comprises a distal femoral plate, and a posterior condylar member having a medial and lateral member, all comprising one piece. The adjustable femoral member comprises a self-adjusting member. The self-adjusting member comprises a spring-loaded member. The self-adjusting member adjusts relative to the stationary femoral member. The positioning feature on the adjustable member is a surface feature. The adjustable femoral member is asymmetrically oriented relative to the stationary member (see FIG. 3, col. 9, lines 42-46). The stationary member is made of a hard polymer, i.e.

Art Unit: 3733

plastic (see col. 9, lines 59-61, and the adjustable member is made of a metal (see col. 8, lines 65-end). The device also comprises a tibial member. The tibial member comprises a shim. There can be apertures drilled asymmetrically through the members to stabilize the trial to the bone (col. 13, lines 50-60).



Claims 1, 20-25, 28-29, 41, 60-61, 63-69 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Gustilo et al. (U.S. Patent No. 5,733,292).

In another embodiment, Gustilo et al. disclose a device comprising a stationary femoral member, an adjustable femoral member movably coupled with the stationary member, and a tibial member that allows the knee to move through a range of motion. The adjustable member comprises a positioning feature. The positioning feature on the

Art Unit: 3733

adjustable member is two apertures (ref. #128), and the device further comprises a grasping feature (ref. #130) coupled to the adjustable femoral member. The adjustable femoral member is asymmetrically oriented relative to the stationary member (see FIG. 3, col. 9, lines 42-46). The adjustable femoral member comprises a plurality of pre-adjusted femoral members (see different embodiments, e.g. FIG. 1 FIG. 25, FIG. 26) having different asymmetries relative to the stationary member. The tibial member comprises a plurality of tibial members having different thicknesses or heights (see tibial members of FIG. 5 and 15). There can be apertures drilled asymmetrically through the members to stabilize the trial to the bone (col. 13, lines 50-60).

With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Gustilo et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Response to Arguments***

Applicant's arguments filed 09/15/2006 have been fully considered but they are not persuasive.

Applicant argues that the Gustilo reference does not teach an adjustable femoral member. As explained above, Gustilo teaches a femoral member (e.g. FIG. 23, ref. #'s 404,400), and the height of this femoral member relative the tibial surface can be adjusted via springs ref. #400, hence the feature of Gustilo et al. can be considered an adjustable femoral member in its broadest reasonable interpretation of the term. Therefore, the fact that the femoral component is "wrapped" around the femur is not sufficient to argue that the femoral component is not adjustable, since the femoral component is adjustable relative the tibia. Applicant should claim the structural differences that distinguish the "adjustable femoral component" of the invention from the component of Gustilo et al. Similarly, the term "positioning feature" is being interpreted in its broadest reasonable sense. The positioning feature of Gustilo (see both ref. #128 as well as the positioning feature shown in the above marked-up diagram of FIG. 23) has a different purpose; it actually changes the position of the device, and therefore can be considered a "positioning feature". While the examiner agrees that the positioning feature of the Gustilo et al. reference and the positioning feature of Applicant's specification differ structurally and functionally, Applicant has not claimed those structural differences and/or has not provided specific enough functional language to distinguish the two devices.

The examiner maintains that the device of Gustilo et al. contains all the claimed limitations. The Applicant is encouraged to include more structural features in order to overcome the Gustilo et al. reference and any other prior art of record.

The rejections are deemed proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

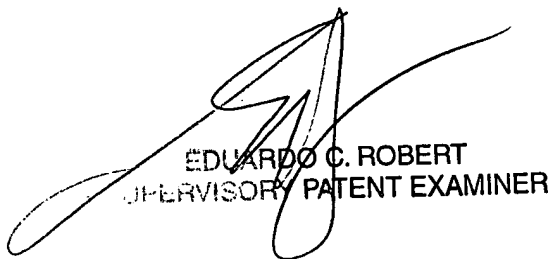
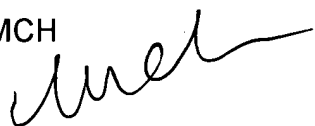
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone

Art Unit: 3733

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER